

**REMARKS**

Claims 37-68 were originally filed in the present application.

Claims 37-68 are pending in the present application.

Claims 37-39 and 42-51 were rejected.

Claims 40, 41, 52 and 53 were objected. As their respective independent claims are allowable, as discussed below, these claims have not been amended to independent form.

Claims 54-68 have been allowed.

Claim 38 has been amended herein to ensure common terminology

Reconsideration of the claims is respectfully requested.

**CLAIM REJECTIONS -- 35 U.S.C. § 102**

Claims 42-48 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,377,809 to *Reziifar, et al.* (hereafter, "Reziifar"), although they had previously been allowed over this very reference. Applicant is disappointed that the assignment of a new Examiner to this application has resulted in the Office taking an inconsistent position on these claims.

Claim 42 requires, among other limitations, "wherein said second base station is capable of sending said data packets to a mobile station on a second channel; wherein said first base station is capable of receiving a negative acknowledgment signal from said mobile station that said mobile station failed to correctly receive at least one data packet from said second base station; wherein said first base station and said second base station are capable of sending at least one replacement data

packet to said mobile station on said second channel at a second higher data rate; and wherein said at least one replacement data packet replaces one of: a missing data packet and an error data packet.”

The Examiner justifies ignoring this limitation, and others, by misapplying the principle of *In re Hutchison*, 154 F.2d 135 (CCPA 1946). In *Hutchinson*, the court did not consider the preamble phrase “adapted for use in the fabrication of a metal template or the like” to “constitute a limitation in any patentable sense.” In contrast, the “capable of” limitation in the present application imposes specific capability requirements on the second base station and first base station, as described in the claim. The Examiner is invited to consider the non-precedential BPAI decision in *Ex parte Prall*, Appeal No. 2003-1556, which may be found at [www.uspto.gov/web/offices/dcom/bpai/decisions/fd031556.pdf](http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd031556.pdf). While the limitation at issue in *Hutchinson* was in the preamble and merely recited an intended use, the limitation at issue in *Prall* imposed a capability requirement on the respective claim element – like that in the current application.

Moreover, the determination of whether clauses such as “capable of” (or “adapted to/for,” or “wherein/whereby”) are a limitation in a claim is not subject to a per se rule, but instead depends on the specific facts of the case. MPEP § 2111.04, page 2100-46 (8th ed., rev. 5, August 2006). When such a clause states a condition that is material to patentability, the clause cannot be ignored in order to change the substance of the invention. *Id.* Ignoring these limitations of the claims is therefore, by definition, not a “reasonable” interpretation.

As above, the Examiner improperly ignores the limitations of these claims that impose affirmative capability requirements on the claimed apparatus, and so fails to make even a *prima facie* anticipation rejection. The rejection is of Claims 42-48 legally deficient.

The Examiner does not even attempt to show that Reziifar's system is capable of performing as claimed. In fact, the Office explicitly stated in the June 1, 2005 Office Action that the art "fails to teach a first base station is capable of receiving a negative acknowledgement signal from said mobile station that said mobile station failed to correctly receive at least one data packet from second base station, combining [*sic*] with rest limitation [*sic*] in the independent claims." Examiner Liou was correct.

The rejection of Claims 38-41 is traversed.

#### **CLAIM REJECTIONS -- 35 U.S.C. § 103**

Claims 37-39 and 49-51 were rejected as obvious over U.S. Patent No. 5,966,384 to *Felix, et al.* (hereafter "Felix") is view of U.S. Patent 6,101,168 to *Chen, et al.* ("Chen"). This rejection is traversed.

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (MPEP § 2142).

The discussion of Felix and Chen made in a previous response is hereby incorporated by reference. Felix teaches transmitting data using a second channel and a second encoding scheme until an interruption in the transmission of data occurs at which point transmission continues on a first channel with a first encoding scheme. Felix discloses a controller that outputs an indication to stop transmission of data over the second channel when either: (1) all the data has been communicated to the remote unit; (2) an allotted time period has expired; or (3) the transmission has simply been interrupted.

In the first situation, Felix discloses that the remote unit will perform an acknowledgement of the last frames transmitted and that error control takes place when: (1) Acknowledging (ACK) packets have been received; and/or (2) Negative Acknowledgement (NAK) for messages whose sequence number has not been received even though later numbered messages have been received. Felix in Figures 5 and 7 provides limited guidance on how data may be retransmitted in Steps 427 and 527, respectively. Steps 427 and 527 indicate that any retransmission of data occurs by transmitting the data at the first transmission rate within the first bandwidth utilizing the first spreading code modulation scheme.

The Examiner does note that some retransmission in Felix's system can occur on the fundamental channel (assuming, as the Examiner does, that the supplemental channel corresponds to the claimed "first channel"). As Felix teaches in col. 2, lines 30-35, when data transmission stops, "any retransmission will take place utilizing the low-speed fundamental channel" (emphasis added). As the claims require that the data rate of the second channel be higher than the data rate of the first channel, Felix's low-speed fundamental channel cannot qualify as the claimed second channel.

Thus, Felix fails to teach or disclose the limitations of sending at least one replacement data packet to said mobile station on a second channel at a second higher data rate; and communicating with a replacement data packet controller capable of receiving said at least one replacement data packet from said base station and incorporating said at least one replacement data packet into a data packet stream to replace one of: a missing data packet and an error data packet. Such limitations are required by independent Claims 37 and 49, as well as their respective dependent claims.

The Examiner now looks to Chen for relevant teachings. The Examiner references Chen's summary of the invention, where it teaches in col. 3, lines 28-45:

Alternately, the packet received in error can be retransmitted on an additional traffic channel which is independent of the traffic channel used to transmit the new packet. Since the retransmitted packet does not delay or impede the transmission of the new packet, the throughput rate is maintained during the retransmission of the packet received in error.

It is another object of the present invention to maximize the capacity of the communication channel by retransmitting the packet received in error with the minimum amount of energy such that the accumulation of the energy of the transmission and retransmission results in the correct decoding of the packet. The packet received in

error can be retransmitted with less energy-per-bit than the new packet which is transmitted for the first time. At the destination device, the energy of each symbol in the packet received in error is accumulated with the energy of each symbol in the retransmitted packet. The accumulated symbols are then decoded.

As may be clearly seen, although Chen does teach in this passage that a retransmission can occur on an “independent channel”, there is no discussion at all of the relative data rates of any channels. The Examiner’s mention of a trade off between operation range and data rate is interesting, but not relevant, as there is no teaching that any trade off is necessary or considered in Chen’s system, or that the operation range is a necessary consideration. Further, the Examiner’s response that Chen’s teaching of sending retransmission with less energy per bit “often would result with [*sic*] higher data rate” is a conclusion simply not supported in the art of record. If the Examiner wishes to rely on such a determination by taking Official Notice, then he is respectfully requested to support this with documentary evidence, as required by MPEP 2144.03.

In fact, a further review of Chen’s disclosure teaches that the retransmission can be made at a full data rate, or a lesser data rate (or at a constant or lesser symbol rate), but there appears to be no teaching at all that the system is capable of sending at least one replacement data packet to a mobile station on a second channel at a second higher data rate which is higher than said first data rate.

As Chen includes no teaching corresponding to the claim limitation, and both Chen and Felix teach directly away from the claim limitations, by teaching retransmission on a slower channel, no combination of these references can teach the claim limitations, and there can be no motivation in

these references to modify either Felix, Chen, or any combination of them to meet the claim limitations.

As the Examiner is surely aware, the motivation to combine or modify must be specific to the actual teachings sought to be combined. "In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention." (Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1385 (Fed. Cir. 2001) emphasis added). "When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention." (In re Dance, 160 F.3d 1339, 1343 (Fed. Cir. 1998), emphasis added).

The Examiner must show a specific teaching in the art to make the specific modification to Felix, Chen, or the Felix/Chen combination to have the second "retransmission" channel have a higher data rate than the first data rate. There is no such teaching or suggestion in the cited art, and so the rejections of claims 37 and 49, and their respective dependent claims, are traversed.

The Examiner is, of course, correct that the combined teachings of the references must be considered when determining obviousness. Here, all the art of record teaches retransmission at the same rate or a slower rate, not the higher rate required by the claims. As this is the case, no

combination of the art of record would teach or suggest a system in accordance with the claims to one of ordinary skill in the art.

All rejections are traversed, and reconsideration and prompt allowance are respectfully requested.



**SUMMARY**

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

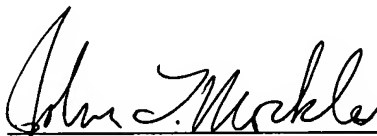
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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